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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,388	08/11/2000	JAMES B. RILEY	LC-1	8885
39069	7590	02/10/2004	EXAMINER	
BECKER & POLIAKOFF, P.A. 3111 STIRLING ROAD FT. LAUDERDALE, FL 33312			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,388

Applicant(s)

RILEY ET AL.

Examiner

Gregory J. Vaughn

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 8/11/2000.
2. Claims 1-44 are pending in the case, claims 1, 18, 33, and 39 are independent claims.

Priority

3. Applicant's claim for domestic priority of US provisional application 60/203,180, filed May 5, 2000, under 35 U.S.C. 119(e) is acknowledged.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "54" in Figure 15.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

- The disclosure recites "*Course Wizard program 38*" (page 15, line 25). The disclosure fails to mention the figure to which this reference number pertains. Figure 9 appears to contain this reference sign.
- The disclosure recites "*Course Wizard program 38*" (page 15, line 25) and "*Course Wizard program 22*" (page 15, line 28). Figure 9 indicates the correct reference sign is 38.
- The disclosure recites "*Finish Button 50*" (page 16, lines 8-9). The disclosure fails to mention the figure to which this reference number pertains. Figure 13 appears to contain this reference sign.
- The disclosure fails to disclose those reference signs listed in paragraph 4 above, which are shown in the drawings.

Appropriate correction is required.

6. The use of the following trademarks has been noted in this application:

- "*WordPerfect*" on page 7, line 23.
- "*Microsoft Word*" on page 7, line 23.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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7. The disclosure is objected to because it contains the following embedded hyperlinks and/or other form of browser-executable code:

- "<http://www.Learn.com>" on page 3, line 26.

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. "

9. Claim 41 recites the limitation "*The system defined in claim 33*" in first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 33 is directed toward a "*method*".

Double Patenting

10. Claim 35 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 41. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

12. Claims 1-16, 18-31 and 33-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al. US Patent 5,806,079 (filed 4/17/1996, patented 9/8/1998). "*Rivette et al.*" is hereafter referred to as "*Rivette*".

13. **In regard to independent claims 1**, the first limitation of the claim is directed toward displaying a document on a display screen. Rivette discloses a displayed document in Figure 6A at reference sign 406.

The second limitation of the claim is directed toward invoking an annotation program that displays an annotation field simultaneously with the document. Rivette discloses in Figure 6B an annotation field of an annotation program. Figure 6B is the right hand side of a display, and Figure 6A is the left hand side of a display. Figure 6A and 6B, when combined at the break line indicated, form a display with both a document and an annotations program displayed simultaneously.

The third limitation of the claim is directed toward a user copying portions of the document into the annotations field. Rivette discloses: "*Such operation is shown in*

FIGS. 6A and 6B. The user selects pen button 410A, which causes the pointer 402 to change to a pen 620. The pen 620 is color coded using color 506, which is the same as the selected pen button 410A. The user selects text 602, which is a portion of patent data object displayed in the application window 408. The notes application 302 instructs the application associated with the application window 408 to color code the selected text 602 using the same color as the pen 620, i.e., color 506. The notes application 302 creates a new note, called Note A, and displays Note A in a note window 606" (column 13, lines 43-52).

14. **In regard to dependent claims 2 and 3**, the claims are directed toward entering user-defined information (claim 2) and user notes (claim 3) into the annotation field. Rivette discloses: *"The contents field 1512 stores the information that the user entered into the sub-note window"* (column 26, lines 29-30).
15. **In regard to dependent claim 4 and 5**, the claims are directed toward the document being a word processor based document (claim 4) or a desktop application (claim 5). Rivette discloses: *"The application window 408 is generated by an application that can process text data objects, such as a word processor"* (column 14, lines 5-7). Rivette also discloses *"MICROSOFT WORD and WORD PERFECT"* (column 2, line 49) and *"MICORSOFT EXCEL"* (column 2, lines 55-56). MICROSOFT WORD, WORD PERFECT and MICORSOFT EXCEL are all examples of desktop applications.

16. **In regard to dependent claim 6**, the claim is directed toward the document being a portion of an Internet site. Rivette discloses: "*The computer applications 312 include any computer applications that generate and/or process information, such as word processing applications, spreadsheet applications, presentation managers, database managers, financial applications, networking applications, communication applications, sound processors, video processors, on-line service applications*" (column 8, line 62 to column 9, line 1).
17. **In regard to dependent claim 7**, the claim is directed toward editing the information contained in the annotations field. Rivette discloses: "*The link view is also useful for editing and replicating the note*" (column 19, lines 15-16).
18. **In regard to dependent claim 8**, the claim is directed toward saving the information contained in the annotations field. Rivette discloses a system in Figure 28 with a *Primary Memory* (reference sign 2808) that stores the *Note database* (reference sign 308).
19. **In regard to dependent claim 9**, the claim is directed toward printing the information contained in the annotations field. Rivette discloses: "*A user can elect to print the notes database 308 while in any of these views, such that the print out has the same appearance to that which is displayed on the computer display*" (column 17, lines 11-14).

20. **In regard to dependent claim 10**, the claim is directed toward generating a summary of the information contained in the annotations field. Rivette discloses a summary view of notes in Figure 29.
21. **In regard to dependent claim 11**, the claim is directed toward generating a user-defined summary of the information contained in the annotations field. Rivette discloses: *"The invention supports a note centric view (also called a note view), an object centric view (also called an object view), a link centric view (also called a link view), and a user-defined view"* (column 17, lines 8-11).
22. **In regard to dependent claim 12**, the claim is directed toward arranging summary information sequentially. Rivette discloses a summary view of notes in Figure 29. The notes are presented sequentially in Figure 29.
23. **In regard to dependent claim 13**, the claim is directed toward providing a reference to the portion of the document that the summary information refers to. Rivette discloses a summary view of notes in Figure 29. Each note shown in Figure 29 is captured in the database as a data record; the data record is shown in Figure 15. Rivette recites: *"The location identifier field 1508 stores information that identifies the location of the selected portion in the data object"* (column 26, lines 13-15).
24. **In regard to dependent claim 14**, the claim is directed toward storing notes from multiple users, and allowing the users to search other user's notes. In regard to multiple users, Rivette discloses: *"Accordingly, what is required is a system and method for enabling the organization and recordation of a person or group's thinking"*

(column 3, lines 50-51). In regard to search capabilities, Rivette recites: *"The invention supports powerful search features for identifying note groupings, notes, sub-notes, links, and/or data objects that satisfy user supplied search criteria. Users can perform key word searches, searches based on date/time of creation or modification, searches based on icon tagging (icons can be predefined or user defined), searches based on creator or owner, searches based on security/privacy levels, etc. Preferably, sub-notes are indexed and searchable. Also, fields (predefined or user defined) within note groupings, notes, and sub-notes are indexed and searchable"* (column 24, lines 54-63).

25. **In regard to dependent claims 15 and 16**, the claims are directed toward storing notes from multiple users on a server (claim 15) or at the user's location (claim 16). Rivette discloses a system in Figure 28 with memory (reference sign 2808) containing a Notes Database (reference sign 308). Furthermore, Rivette discloses in Figure 3A, a Notes Database (reference sign 308) running on a single machine (server) (reference sign 302). In Figure 38, Rivette discloses multiple Note Information Databases (on user's machines) (reference signs 3406A and 3406B).
26. **In regard to claims 18-21**, the claims contain substantially the same subject matter as claims 1-4 respectively, and are rejected with the same rational.
27. **In regard to claims 22-26**, the claims contain substantially the same subject matter as claims 6-10 respectively, and are rejected with the same rational.

28. **In regard to claims 27-31**, the claims contain substantially the same subject matter as claims 12–16 respectively, and are rejected with the same rational.
29. **In regard to independent claims 33 and 39**, the claims contain substantially the same subject matter as claims 1 and 14 combined, and are rejected with the same rational.
30. **In regard to claims 34 and 40**, the claims contain substantially the same subject matter as claim 15, and are rejected with the same rational.
31. **In regard to claims 35 and 41**, the claims contain substantially the same subject matter as claim 16, and are rejected with the same rational.
32. **In regard to claims 36 and 42**, the claims contain substantially the same subject matter as claim 6, and are rejected with the same rational.
33. **In regard to dependent claims 37 and 43**, the claims are directed toward a web page that is an on-line course. A web page is rejected as described in reference to claim 6 above. Rivette also discloses: *"The invention is applicable to any application that would benefit from the enhanced organization of information. Such applications include, but are not limited to: (1) law related projects, ... (6) review course, such as legal bar review course, business review courses, CPA courses, medical review courses, etc.; and (7) virtual classrooms"* (column 37, line 59 to column 38, line 5).
34. **In regard to claims 38 and 44**, the claims contain substantially the same subject matter as claims 1 and 14 combined, and are rejected with the same rational.

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

36. Claims 17 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette.

37. In regard to dependent claims 17 and 32, the claims are directed toward searching the notes using a web browser. Rivette discloses an annotation system with multiple users and searching as described above. Rivette fails to disclose a web browser. However, Rivette recites: *"FIG. 38 illustrates an example implementation of the invention. In this example, the note information database 3406 is distributed among sites 3804 and 3406. The note/object linking information database 3408 is distributed among sites 3806, 3810, and 3812. These sites are connected via a network 3820, which may represent any type of communication medium in any form or configuration, such as a public network (the Internet, for example)"* (column 24, lines 33-40). Rivette further discloses: *"The computer applications 312 include any computer applications that generate and/or process information, such as word processing applications, spreadsheet applications, presentation managers, database*

managers, financial applications, networking applications, communication applications, sound processors, video processors, on-line service applications" (column 8, line 62 to column 9, line 1). Rivette teaches a computer application that is Internet enabled like a web browser.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to combine a computer application that is Internet enabled with an annotation system to provide "*enabling the organization and recordation of a person or group's thinking, work product, and data objects collected or generated during a project or task. Such organization and recordation serves to institutionalize the person or group's thinking, work product, and data objects, thereby protecting against the unavailability of persons, memory loss, or loss of work product* (Rivette, column 3, lines 51-57).

Conclusion

38. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-6,178,431	01-2001	Douglas, Gavin L.
• US-6,243,722	06-2001	Day et al.
• US-6,279,014	08-2001	Schilit et al.
• US-6,331,866	12-2001	Eisenberg, Peter M.
• US-6,345,284	02-2002	Dinkelacker, James Walter
• US-6,360,236	03-2002	Khan et al.
• US-6,389,434	05-2002	Rivette et al.
• US-6,415,316	07-2002	VanDer Meer, Joannes Jozef Everardus
• US-6,502,113	12-2002	Crawford et al.
• US-6,571,295	05-2003	Sidana, Ashmeet S.
• US-6,584,479	06-2003	Chang et al.
• US-2003/0196164	10-2003	GUPTA et al.

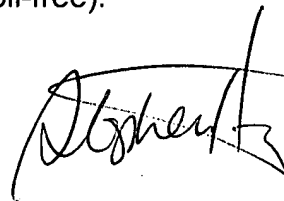
39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
February 4, 2004

A handwritten signature in black ink, appearing to read "Stephen S. Hong", with a stylized flourish at the end.

STEPHEN S. HONG
PRIMARY EXAMINER